

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : HIRSCH, Alan R.
Serial No. : 10/690,791
Filing Date : October 22, 2003
Examiner : FLOOD, Michele C.
Group Art Unit: 1655
For : Method of Altering Weight Perception
Confirmation No.: 5622
Docket No. : INS-31875 [incorrectly shown as TAD-32179]

CERTIFICATION OF SUBMISSION

I hereby certify that, on the date shown below, this correspondence is being transmitted via the Patent Electronic Filing System (EFS) addressed to Examiner FLOOD at the U.S. Patent and Trademark Office.

Date: December 11, 2006 J. L. Palmatter

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

Applicant requests consideration of the pending claims in the above-identified patent application based on the remarks herein.

Response to Restriction begins on page 2 of this paper.

Response to Restriction Requirement.

In response to the Examiner's requirement for restriction, Applicant elects **Group I**, Claims 1-4 and 26, *with traverse*.

Traversal. The Examiner maintains that there are nine different inventions, I-IX, and that each of these are unrelated, stating as follows:

In the instant case, the nine different inventions are directed to nine methods encompassing different experimental parameters, different process steps, different concentrations of a mixture of ingredients, wherein the ingredients are not necessarily the same; and there provide different functional effects as evidenced by the claims themselves. These methods are independent since they are not disclosed as capable of use together, they have different functions, and/or they had different effects. One would not have to practice the various methods at the same time to practice just one method alone.

The Examiner's assertion is without basis or support. Applicant requests reconsideration and restructuring of the identified groups.

The Examiner is respectfully directed to MPEP § 808.02 (emphasis added):

808.02 Establishing Burden

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP § 806.05). If applicant voluntarily files claims to such related inventions in different applications, double patenting may be held.

Where the * inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, *must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:*

(A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. *Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.*

(C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.

First of all, all of the claims are classified in the same class. Thus, contrary to the Examiner's assertion, the claims do not require a different field of search, and the Examiner has not established a separate status in the art.

As to the claims of **Groups I-VI** – each of the claims recite:

- 1) The same function: A method of modifying/altering perception of body weight –
- 2) The same processing step: administering to a person for inhalation –
- 3) The same ingredients: a composition comprising a floral odorant and a spice odorant –
- 4) The same concentration: a suprathreshold but non-irritant amount
- 5) The same effect: such that the person perceives the body weight to be (about 5-10%) less than actual body weight.

I	II	III	IV	V	VI
1. A method of modifying perception of body weight	5. A method of modifying perception of body weight	6. A method of modifying a person's perception of their body weight	7. A method of modifying perception of body weight	8. A method of modifying perception of body weight	27. A method of altering perception of body weight
administering to a person for inhalation	administering to a person for inhalation	administering... to the person for inhalation	administering to a person for inhalation	administering ...to a first person for inhalation	administering to a first person for inhalation
a composition comprising ...a floral odorant and a spice odorant a suprathreshold but non-irritant amount (Claim 2)	a composition comprising a suprathreshold but non-irritant amount of ...a floral odorant and a spice odorant	a composition comprising a suprathreshold but non-irritant amount of ...a floral odorant and a spice odorant	a composition comprising a suprathreshold but non-irritant amount ...a floral odorant and a spice odorant	a composition comprising a suprathreshold but non-irritant concentration of ...a floral odorant and a spice odorant	a composition comprising a suprathreshold but non-irritant amount of ...a floral odorant and a spice odorant
such that the person perceives the body weight to be about 5-10% less than actual body weight	such that the person perceives the body weight to be about 5-10% less than actual body weight	such that the person perceives the body weight to be about 5-10% less than actual body weight	such that the person perceives the body weight to be less than the actual body weight	such that the first person perceives the body weight of a second person to be less than actual body weight of the second person	such that the first person perceives the body weight of a second person to be less than actual body weight of the second person
					the floral odorant selected from a recited group
					the spice odorant selected from a recited group
Class 424/725 Class 514/909	Class 424/725 Class 514/909	Class 424/725 Class 514/909	Class 424/725 Class 514/909	Class 424/725 Class 514/909	Class 424/725 Class 514/909

As to the claims of **Groups VII-VIII** – each of the claims recite:

- 1) The same function: A method of altering perception of body weight –
- 2) The same processing steps:
 - a) testing olfactory ability
 - b) administering to a person for inhalation –
- 3) The same ingredients: a composition comprising a floral odorant and a spice odorant –
- 4) The same concentration: a suprathreshold but non-irritant amount
- 5) The same effect: such that the person perceives their body weight or the body weight of another individual to be less than actual body weight

VII	VIII
34. A method of altering perception of body weight	36. A method of altering perception of body weight
testing olfactory ability	testing olfactory ability
administering to the person for inhalation	administering to the person for inhalation
a composition <i>comprising</i> a suprathreshold but non-irritant amount of ...a floral odorant and a spice odorant	a composition <i>consisting essentially of</i> a suprathreshold but non- <i>irritant</i> concentration of ...a floral odorant and a spice odorant
such that the person perceives their body weight or the body weight of another individual to be less than actual body weight	such that the person perceives their body weight or the body weight of another individual to be less than actual body weight
Class 424/725 Class 514/909	Class 424/725 Class 514/909

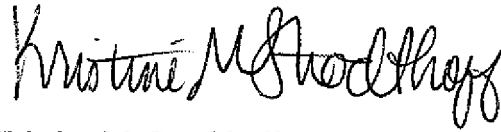
The Examiner has not meet her burden under the requirements of MPEP § 808.02 to insist on the restriction of claims.

Applicant requests reconsideration and restructuring of the identified groups such that the claims of Groups I-VI are grouped together, and the claims of Groups VII-VII are grouped together.

Extension of Term. The proceedings herein are for a patent application and the provisions of 37 CFR § 1.136 apply. Applicant believes that a three-month extension of term is required. Please charge the required fee (large entity) to Account No. 23-2053. If an additional extension is required, please consider this a petition therefor, and charge the required fee to Account No. 23-2053.

It is respectfully submitted that the claims are in condition for allowance and notification to that effect is earnestly solicited.

Respectfully submitted,



Kristine M. Strodthoff
Reg. No. 34,259

Dated: December 11, 2006

WHYTE HIRSCHBOECK DUDEK S.C.
555 East Wells Street
Suite 1900
Milwaukee, Wisconsin 53202-3819
(414) 273-2100

Customer No. 22202